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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,072	06/19/2003	Jean-Philippe Girard	BIOBANK.009CP1	5184

20995 7590 12/15/2005

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EXAMINER	
YAO, LEI	

ART UNIT	PAPER NUMBER
1642	

DATE MAILED: 12/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/601,072	GIRARD ET AL.	
	Examiner	Art Unit	
	Lei Yao, Ph.D.	1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2003*.

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-91* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-91* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Election/Restrictions

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-14, drawn to a method of forming a complex comprising contacting a chemokine with a chemokine-binding agent of THAP-1, domain of THAP-1 or polypeptide having 30% identity to THAP-1, classified in class 435, subclass 4.

II. Claims 15-28, drawn to a method of inhibiting the activity of a chemokine, comprising contacting a chemokine with an effective amount of an agent comprising a polypeptide selected form the group consisting of THAP-1, classified in class 435, subclass 4.

III. Claims 29-42, drawn to a method of reducing inflammation comprising administering to a subject afflicted with an inflammatory condition an effective amount of a chemokine binding agent comprising THAP-1 or polypeptide having a 30% identity to THAP-1, classified in class 514, subclass 2

IV. Claims 43-57, drawn to a method of **reducing symptoms associated with an inflammaoty disease**, comprising administering to a subject afflicted with inflammatory disease an agent to reduce or eliminated the activity of one or more chemokines, wherein the agent comprise THAP-1 or polypeptide having at least 30% identity to THAP-1 or a chemokine binding domain of THAP-1, classified in class 514, subclass 2.

V. Claims 58-67, drawn to a method of detecting a chemokine comprising contacting a chemokine with a chemokine-binding agent, and a detection system comprising a chemokine binding agent, classified in class 435, subclass 4.

VI. Claims 68-86, drawn to a pharmaceutical composition, a kit and a device for administering comprising a chemokine-binding agent comprising a THAP-1 or polypeptide having a at least 30% of identity of THAP-1, classified in class 514, subclass 2.

VII. Claims 88, an isolated chemokine-binding domain consisting essentially of a portion of SEQ ID NO:3 that binds to a chemokine, wherein the chemokine is CCL19, , classified in class 530, subclass 350.

VIII. Claims 89, an isolated chemokine-binding domain consisting essentially of a portion of SEQ ID NO: 3 that binds to a chemokine, wherein the chemokine is CCL5, , classified in class 530, subclass 350.

IX. Claims 90, an isolated chemokine-binding domain consisting essentially of a portion of SEQ ID NO:3 that binds to a chemokine, wherein the chemokine is CXCL9, , classified in class 530, subclass 350.

X. Claims 91, an isolated chemokine-binding domain consisting essentially of a portion of SEQ ID NO:3 that binds to a chemokine, wherein the chemokine is CXXL10, , classified in class 530, subclass 350.

Claims 87 link(s) inventions VII to X The restriction requirement between /among the linked inventions is subject to the nonallowance of the linking claim(s), claim 87 Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to exami-nation in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutorydouble patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. In re Ziegler, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Inventions are distinct each from the other because of the following reasons:

Inventions Group VI-X and Group I- V are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as

claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the chemokine or pharmaceutical composition of Group VI-X can be used to immunize an animal to produce an antibody, as opposed to being used to treat disease or form a complex.

Searching the one or more inventions Groups VI-X together with one or more invention I-V would impose serious search burden. The inventions have a separate status in the art as shown by their different classifications and the searching is not co-extensive.

Inventions VI-X are patentably distinct products.

Inventions I-V are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). Invention I-V are unrelated because each invention requires different material and are involved in a different method steps and have different modes of operation. Therefore, each invention may need different patient population or biological samples from different patients. Invention I is method for forming a complex between a chemokine and binding agent in vitro. Invention II is method of inhibiting the activity of a chemokine by biding to the chemokine binding agent comprising THAP-1. Invention III-V are method for treating a different disease conditions, they may require different patient populations and have different modes of operations.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

Election of Species

This application contains claims directed to the following patentably distinct species of the claimed invention:

A. SLC
B. CCL19
C. CCL5
D. CXCL9
E. CXCL10

In the event that applicant elects any one invention from I-VI, applicant is required under 35 U.S.C. 121 to elect a single disclosed species from A) to E) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitation of the allowable product claim will be rejoined in accordance with the provisions of M.P.E.P. 821.04. Process claims that depend from or otherwise include all the limitation of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after allowance are governed by 37 C.F.R. 1.312.

In the event of a rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 C.F.R. 1.104. Thus, to be allowable, the rejoined claims must meet the criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C. 103(b), 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that process claims should be amended during prosecution either to maintain dependency on the product claims or otherwise include the limitation of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See

M.P.E.P. 804.01.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lei Yao, Ph.D. whose telephone number is 571-272-3112. The examiner can normally be reached on 8am-4.30pm Monday to Friday.

Any inquiry of a general nature, matching or file papers or relating to the status of this application or proceeding should be directed to Kim Downing for Art Unit 1642 whose telephone number is 571-272-0521

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Siew can be reached on 571-272-0787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Lei Yao, Ph.D.
Examiner
Art Unit 1642

LY

JEFFREY SIEW
SUPERVISORY PATENT EXAMINER
12/9/05